

### **Remarks/Arguments**

Applicant thanks Examiner Mooneyham for her careful examination of this application and for the clear explanation of the claim rejections. In response to the Office Action of October 12, 2006, applicant amends claim 15 to describe the embodiment invention more clearly. Regarding the 103(a) rejection against claims 1 through 20, applicant respectfully submits that because the cited reference does not disclose all the elements in the pending claims, the Office Action fails to establish a prima facie case of obvious against the pending claims.

### **Claim 1**

Claim 1 describes a method for processing specification waiver requests over a network. The network connects a waiver requestor to a plurality of responders. The waiver is relative to a specification of a plurality of elements. The method includes the following steps:

- a. providing a waiver request database that is operable to store a plurality of waiver requests from the waiver requestor;
- b. receiving at the waiver request database a waiver request from the requestor, the request seeking a waiver of at least one of the specification elements from at least one of the plurality of responders;
- c. sending a notification from the waiver request database to the plurality of responders, seeking the requested waiver of the at least one specification element; and
- d. transmitting data from the waiver request database to the requestor, whereby the requestor may determine whether the waiver request has been approved by at least one of the plurality of responders. (emphases added)

Claim 1 is rejected under 35 U.S.C. 103(b) as being unpatentable over Anecki et al.<sup>1</sup> However, the Anecki reference does not disclose at least the underlined elements:

First, the Office Action asserts that Anecki discloses the step of “providing a legal document database to store a plurality of requests (Anecki fig. 2, item 1110).”<sup>2</sup> This assertion, however, is not supported by the Anecki reference, which describes item 1110 as follows:

The legal document server receives the legal document request and begins to process the request 1110. A request can be processed by generating a legal document using the information contained in the request.<sup>3</sup>

The Anecki reference discloses a legal document server that receives and processes legal document requests; it does not disclose a database that stores a plurality of requests. The system disclosed in the Anecki reference stores the following items: legal documents such as NDAs,<sup>4</sup> legal document templates;<sup>5</sup> “boilerplate” provisions of the legal document;<sup>6</sup> documents for tracing, reporting, and modification purposes;<sup>7</sup> identification of a document;<sup>8</sup> computer program instructions;<sup>9</sup> and a file system of the legal documents.<sup>10</sup> Legal document request, however, is not disclosed as being a stored item in the system.

Second, the Anecki reference does not disclose receiving a waiver request seeking a waiver of at least one of the specification elements from at least one of the plurality of responders. The Anecki reference only requires a legal document request to include “recipient and subject matter information sufficient to create a

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<sup>1</sup> U.S. Patent Application Publication No. 2006/0010377, published Jan. 12, 2006 from an application filed Sep. 13, 2005 by John A. Anecki et al.

<sup>2</sup> Office Action of Oct. 12, 2006, page 2.

<sup>3</sup> Anecki, *supra*, ¶. [0049].

<sup>4</sup> *Id.* ¶ [0040].

<sup>5</sup> *Id.* ¶ [0044].

<sup>6</sup> *Id.* ¶ [0050].

<sup>7</sup> *Id.* ¶ [0055].

<sup>8</sup> *Id.* ¶ [0059].

<sup>9</sup> *Id.* ¶ [0062].

<sup>10</sup> *Id.* ¶ [0071].

legal document.”<sup>11</sup> There is no evidence that the system in the Anecki reference is relative to a specification having a plurality of elements and that the waiver request is seeking a waiver of at least one of the specification elements.

It may be possible to modify the Anecki system, following the description of applicant's invention in this application to incorporate the missing elements of claim 1; but patent law does not permit such use of hindsight in determining the patentability of a claimed invention.<sup>12</sup> Even though Examiner Mooneyham clearly explains the definition of a waiver in the Office Action;<sup>13</sup> this does not cure the deficiency of the Anecki reference, which fails to disclose at least the elements listed above.

Because the Anecki reference cited in the Office Action does not disclose all the claim elements in claim 1, and the Office Action failed to provide evidence that the missing elements are well known in the art, and there is no evidence of motivation for combining the elements, the Office Action fails to establish a prima facie case of obviousness against claim 1. Applicant respectfully submits that claim 1 stands patentable over the Anecki reference.

#### Claims 2 through claim 14

Claims 2 through 14 depend properly from claim 1. Because claim 1 stands patentable, applicant respectfully submits that claims 2 through 14 also stand patentable at least by virtue of their dependence.

#### Claims 15 and 16

Claim 15 describes a computer readable medium that carries sequences of instructions. This claim is also rejected under 35 U.S.C. 103(b) as being unpatentable over Anecki et al.

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<sup>11</sup> *Id.* ¶ [0006].

<sup>12</sup> See, e.g., *In re Zurko*, 111 F.3d 887, 42 USPQ2d 1476 (Fed. Cir. 1997).

<sup>13</sup> Office Action, *supra*, page 3.

Claim 15 includes the steps of providing for a database operable to store a plurality of waiver requests from the waiver requestor and receiving a waiver request seeking a waiver of at least one of the specification elements.

As explained above relating to claim 1, the Anecki reference does not disclose these steps. Nor is there any evidence of motivation set forth in the Office Action to support combining the missing elements with the Anecki system. Therefore, applicant respectfully submits that the Office Action fails to establish a prima facie case of obviousness against claim 15 and claim 15 stands patentable over the Anecki reference.

Claims 16 properly depends from claim 15 and stands patentable over the Anecki reference at least by virtue of its dependence.

#### Claim 17

Claim 17 describes a waiver request system that includes the element of a database server configured to receive a request to waive at least one step of a process. This claim is also rejected under 35 U.S.C. 103(b) as being unpatentable over Anecki et al.

The Anecki reference discloses a system for generating a legal document; there is no evidence that it concerns with any process step. And for the same reason as presented relating to claim 1, the Office Action fails to establish a prima facie case of obviousness against claim 17 because the cited reference does not disclose all the elements in claim 17 and the Office Action fails to set forth any motivation of combining the missing element in the Anecki system. Therefore, applicant respectfully submits that claim 17 stands patentable over the Anecki reference.

#### Claims 18 through 20

Claims 18 through 20 depend properly from claim 20, applicant respectfully submits that they also stand patentable at least by virtue of their dependence.

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In light of the amendment to claim 15 and the reason set forth above, applicant respectfully requests further examination of this application and timely allowance of the pending claims.

Respectfully submitted,

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